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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/542,174

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Robert Wiest

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04/01/2008

PAUL, HASTINGS, JANOFSKY & WALKER LLP
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EXAMINER

FERTIG, BRIAN E

ART UNIT

PAPER NUMBER

3694

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/542,174	WIEST ET AL.	
	Examiner	Art Unit	
	BRIAN FERTIG	3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/14/2005 and 2/11/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1

This claim recites "means for" plus function language. This language invokes the rebuttable presumption that applicant seeks treatment under 35 U.S.C. 112, sixth paragraph. Such treatment requires that applicant clearly identify particular structures or steps within the disclosure as the means for or steps for that applicant intends to claim (see MPEP § 2181). No such clear identification has been found, rendering the claim indefinite. For the purposes of examination below, it is assumed that applicant did not intend to invoke treatment under 35 U.S.C. 112, sixth paragraph. Applicant is advised to explicitly rebut the presumption that 35 U.S.C. 112, sixth paragraph treatment has been invoked, amend the claims to remove the invoking language, or point out language in the disclosure that clearly identifies the particular structures or steps applicant intends to claim.

With respect to claims 2-9

These claims are rejected for incorporated the subject matter rejected in claim 1 above.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8, and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,141,653 to Conklin (Conklin) in view of US Patent Application Publication 2002/0046169 for Keresman (Keresman).

With respect to claim 1

Conklin teaches:

A computerized transaction server for concluding contracts between a service user and a service provider, comprising

a user interface with a number of data input modules which comprise data input fields for inputting data relating to the object of a contract, which user interface is operable for service users by means of terminals via a telecommunication network (see col 17, lines 14-34 and col 25, lines 42-59, and fig 15b, note that users interact using a standard web browser to view forms, via the Internet),

stored data rules assigned to the data input fields and validation means for checking data values input via the data input

fields on the basis of the assigned data rules, and for generating a validation result, characterized by stored business rules assigned to one or more of the data input fields (see col 19, lines 7-13, and 38-57, note that data is validated against frivolous and fraudulent inquirers based upon demographic information stored in the database),

evaluation means for evaluating the data values input via the data input fields on the basis of the assigned business rules and for generating a corresponding evaluation result, a number of different contract negotiation processes for indicating a contract price via the user interface, for requesting and receiving an agreement relating to the conclusion of a contract from the service user via the user interface, and for storing a concluded contract (see col 19, lines 38-57, note that concluded deals are stored by the system, see also col 25, lines 12-35, note that contract terms, including price, are negotiated through the negotiations engine)

control means for activating a first one of the data input modules, for activating the evaluation means in the case of a positive validation result, and for automatically selecting and activating a further one of the data input modules or one of the contract negotiation processes in dependence on the evaluation result (i.e. negotiations engine, see col 28, lines 9-22, notes the

negotiations engine performs the steps pictured in Fig 4b, upon positive validation of user name and password, the customer is presented with customization items).

Conklin does not explicitly teach:

for requesting corrections via the user interface on the basis of the assigned data rules

Keresman teaches:

for requesting corrections via the user interface on the basis of the assigned data rules (see par 52, note that corrections to the default shipping address are requested)

It would have been obvious to one of ordinary skill at the time of applicant's invention to have provided Conklin with the correction features of Keresman in order to allow users to correct default choices so that the inputs conform to the user's wishes as taught implicitly by Keresman (see par 52) since the user wishes to change the shipping address to an alternate address.

With respect to claim 2

Conklin in view of Keresman teaches:

The transaction server as claimed in claim 1 (see rejection of claim 1 above), characterized in that the business rules in each case comprise rule logic and one or more rule parameters, that the transaction server comprises a rules database, and that the rule parameters are stored in the rules database (see Conklin col 19, lines 39-56, note that input data is

validated to prevent fraudulent inquiries using data archived by the negotiation engine, stored in the sponsor database, see Conklin col 19, lines 7-14).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 3

Conklin in view of Keresman teaches:

The transaction server as claimed in claim 2 (see rejection of claim 2 above), characterized in that the rule logic is stored executable program code in the rules database (see Conklin col 19, lines 39-56, note that it is implicit that the rule logic is a stored executable program because the negotiation engine automatically validates the incoming data).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 4

Conklin in view of Keresman teaches:

The transaction server as claimed in claim 1 (see rejection of claim 1 above), characterized in that the data rules and business rules are in each case assigned to one of a number of sets of rules, that the control means are adapted to select a set of rules to be applied from the sets of rules in dependence on at least one data value input into a particular data input field, and that the validation means and the evaluation means are adapted

to check and to evaluate, respectively, the data values input on the basis of the data rules or business rules, respectively, of the set of rules to be applied (see Conklin col 19, lines 39-56, note that input data is validated to prevent fraudulent inquiries using data archived by the negotiation engine, stored in the sponsor database, see Conklin col 19, lines 7-14 see also Conklin col 25, lines 12-35, note that contract terms, including price, are negotiated through the negotiations engine).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 5

Conklin in view of Keresman teaches:

The transaction server as claimed in claim 4 (see rejection of claim 4 above), characterized in that geographic data, user identification data and/or service identification data are in each case assigned to the sets of rules, and that the control means are adapted to select the set of rules to be applied in dependence on a geographic data value (i.e. address) input or a data value for user identification input, respectively, and/or a data value for service identification input (see Conklin Fig 15 C-1, note that the letter of credit is customized to include the address of the user).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 6

Conklin teaches:

The transaction server as claimed in claim 1 (see rejection of claim 1 above), but does not explicitly teach characterized in that at least one of the contract negotiation processes is adapted to automatically calculate the contract price on the basis of data values input.

Keresman teaches:

characterized in that at least one of the contract negotiation processes is adapted to automatically calculate the contract price on the basis of data values input (see par 36, and par 54).

It would have been further obvious to one of ordinary skill in the art at the time of applicant's invention to have provided Conklin with the price validation and total price calculation features of Keresman in order to allow a customer to limit the size of valid purchase and to facilitate the completion of the transaction as taught explicitly by Keresman (see par 36 and 54)

With respect to claim 7

Conklin in view of Keresman teaches:

The transaction server as claimed in claim 1 (see rejection of claim 1 above), characterized in that at least one of the contract negotiation processes is adapted to make the data values input electronically accessible to a responsible human representative of the service provider, to receive data inputs from the human representative and to indicate them to the service user via the user interface and to negotiate the contract

price by data exchange via the user interface between the service user and the human representative (see Conklin col 18, lines 7-11 and Fig 31C, note the involvement of moderator and customer service)
(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 8

Conklin in view of Keresman teaches:

The transaction server as claimed in claim 1 (see rejection of claim 1 above), characterized in that the control means are adapted to store the data values input, the validation result generated and the evaluation result generated assigned to one another (see Conklin, col 15, lines 17-29 and Conklin col 19, lines 7-14, 39-57).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 10

Conklin in view of Keresman teaches:

A computer program product comprising a computer-readable medium with computer program code means contained therein for controlling one or more processors of a transaction server for concluding contracts between a service user and a service provider, in such a manner that the transaction server provides

a user interface with a number of data input modules which comprise data input fields for inputting data relating to the object of a contract, which user interface is operable for service users by means of terminals via a telecommunication network (see Conklin col 17, lines 14-34 and Conklin col 25, lines 42-59, and Conklin fig 15b, note that users interact using a standard web browser to view forms, via the Internet),

in that data rules are stored in the transaction server assigned to the data input fields, in that data values input via the data input fields are checked in the transaction server on the basis of the assigned data rules (see Conklin col 19, lines 7-13, and 38-57, note that data is validated against frivolous and fraudulent inquirers based upon demographic information stored in the database),

in that the transaction server requests corrections via the user interface on the basis of the assigned data rules (see Keresman par 52, note that corrections to the default shipping address are requested),

and in that the transaction server generates a validation result (see Conklin col 19, lines 39-56, note that input data is validated to prevent fraudulent inquiries using data archived by the negotiation engine, stored in the sponsor database, see Conklin col

19, lines 7-14, also log on validation, see Conklin col 28, lines 9-12),

characterized in that the computer program product comprises further computer program code means which control the processors of the transaction server in such a manner, that business rules are stored in the transaction server assigned to one or more of the data input fields (see Conklin col 19, lines 39-56, note that input data is validated to prevent fraudulent inquiries using data archived by the negotiation engine, stored in the sponsor database, see Conklin col 19, lines 7-14),

that the transaction server activates a first one of the data input modules, that the transaction server, in the case of a positive validation result, evaluates the data values input via the data input fields on the basis of the assigned business rules and generates a corresponding evaluation result, and that the transaction server selects and activates a further one of the data input modules or one of a number of different contract negotiation processes in dependence on the evaluation result (see Conklin col 28, lines 9-22, notes the negotiations engine performs the steps pictured in Fig 4b, upon positive validation of user name and password, the customer is presented with customization items), the contract negotiation processes being adapted to control the processors of

the transaction server in such a manner that the transaction server indicates a contract price via the user interface (see Conklin col 25, lines 12-35, note that contract terms, including price, are negotiated through the negotiations engine), that the transaction server requests and receives an agreement relating to the conclusion of a contract from the service user via the user interface, and that the transaction server stores a concluded contract (see Conklin col 19, lines 46-48, note that the concluded deal is archived).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 11

Conklin in view of Keresman teaches:

The computer program product as claimed in claim 10 (see rejection of claim 10 above), characterized in that it comprises further computer program code means which control the processors of the transaction server in such a manner that the transaction server stores rule parameters contained in the business rules in a rules database (i.e. stores demographic information used to validate transaction that are not frivolous or fraudulent, see col 19, lines 50-56).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 12

Conklin in view of Keresman teaches:

The computer program product as claimed in claim 10 (see rejection of claim 10 above), characterized in that it comprises further computer program code means which control the processors of the transaction server in such a manner that the transaction server stores a rule logic contained in the business rules as an executable program code in a rules database. (see Conklin col 19, lines 39-56, note that it is implicit that the rule logic is a stored executable program because the negotiation engine automatically validates the incoming data).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

With respect to claim 13

Conklin in view of Keresman teaches:

The computer program product as claimed in claim 10 (see rejection of claim 10 above), characterized in that it comprises further computer program code means which control the processors of the transaction server in such a manner that the transaction server in each case stores the data rules and business rules assigned to one of a number of sets of rules, that the transaction server selects from the sets of rules one set of rules to be applied in dependence on at least one data value input into a particular data input field, and that the transaction server checks and evaluates, respectively, the data values input on the basis of the data

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rules or business rules, respectively, of the set of rules to be applied (see Conklin col 19, lines 39-56, note that input data is validated to prevent fraudulent inquiries using data archived by the negotiation engine, stored in the sponsor database, see Conklin col 19, lines 7-14 see also Conklin col 25, lines 12-35, note that contract terms, including price, are negotiated through the negotiations engine).

(see rationale supporting obviousness and motivation to combine of claim 1 above)

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Conklin in view of Keresman and in further view of International Publication WO 02/039358 for Hele (Hele), cited by applicant.

With respect to claim 9

Conklin in view of Keresman teaches:

The transaction server as claimed in claim 1 (see rejection of claim 1 above), but does not explicitly teach, characterized in that the transaction server is adapted to conclude reinsurance contracts between an insurance company as service user and a reinsurance company as service provider and that the data relating to the object of a contract comprise information on insurance products and sums insured

Hele teaches:

characterized in that the transaction server is adapted to conclude reinsurance contracts between an insurance company as service user and a reinsurance company as service provider and that the data relating to the object of a contract comprise information on insurance products and sums insured (see pg 1, line 30-pg 2, line 32)

It would have been obvious to one skilled in the art at the time of applicant's invention to have provided Conklin in view of Keresman with the teaching of the applicability of transaction servers to the sale of insurance via the internet in order to streamline the sales process as taught explicitly by Hele (see pg 10, line 24-25)

Inquiry

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN FERTIG whose telephone number is (571)270-5131. The examiner can normally be reached on Monday - Friday 8:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B.F./

/Mary Cheung/
Primary Examiner, Art Unit 3694